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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,641	07/20/2001	Perriann M. Holden	1827-U-01 CIP	2605

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EXAMINER
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HOEY, ALISSA L

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 07/02/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/910,641

Applicant(s)

HOLDEN, PERRIANN M.

Examiner

Alissa L. Hoey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-10,12-32 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-10,12-32 and 34-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The indicated allowability of claims 4,5,9 and 10 in paper No. 11, mailed October 29, 2002, is withdrawn in view of the rejections set forth below.

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-5, 7-10 and 12-32 in Paper No. 12, filed November 21, 2002 is acknowledged. Claims 6, 11 and 33 are now cancelled as presented in paper 12.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4,5,9,10, 12-32 and 34-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
4. Claims 4 and 5 define the invention as presently claimed as a kit having " a decoration to be applied to said bottom surface." As best understood, this required part of the kit sets forth a separate part of a decoration, which is to be applied to the bottom surface, when worn on the protective pad. The specification as originally filed provides a pad that is trimable and has a bottom surface layer that is decorated with a design. (See page 4, lines 4-8). There is no disclosure presented in the originally filed application to offer support for the claims as presently filed.

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5. Claims 9 and 10 require that the method as presently claimed provide "decoration selected from at least one of the groups comprising color, pattern, graphic design, text, advertising, relief design and texture" in addition to a trimable pad with adhesive with a peelable film. The specification requires that the decoration be applied to the bottom surface of the pad. As presently claimed it could be applied to the adhesive, the second surface or the peelable film. Additionally claims 9 and 10 suggest, as best understood, that the pad is not only attached to a body part but to either a number of particular materials (claim 10) or to a pre-formed cupped protector (claim 9). There is no disclosure presented in the originally filed application to offer support for the claims as presently filed.

6. Claims 4 and 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for having a trimable pad with hook or loop fasteners and a pre-formed cup-like protector, does not reasonably provide enablement for a trimable pad with decorations for the pad and a pre-formed cup-like protector for use together. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Both claims 4 and 9 require the use of a decorated pad and the inclusion of a pre-formed cupped pad. While each has been disclosed in the original specification their use together has not been described in such a way as to enable one of ordinary skill in the art the ability to make and or/use the invention without undue experimentation.

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7. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for having an adhesive material, does not provide enablement for the adhesive material being non-irritating. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

8. Claims 24-32 and 34-46 are rejected under 35 U.S.C. 112, first paragraph as being dependent upon claims 4, 9, 10 and 23.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 9 and 10 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 7 filed May 20, 2002. In that paper, applicant has stated that the pad is decorated and applied directly to the wearers body (see page 5 through page 7 of Applicant's arguments), and this statement indicates that the invention is different from what is defined in the claim(s) because the present invention alludes to the pad having a decorated side, an adhesive side and where the adhesive side has a removable cover which can be applied to the user's body or to a separate pre-formed cupped pad or material selected from a particular group as recited in claim 10.

11. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Claims 9 and 10 include language that is essentially identical except for the last phrase in each paragraph. It is questioned if the claims are incompletely written method claims failing to suggest that the material of the protective pad be found in the particular material or shape or that the pad be attachable not only to the wearer's body, but to the particular material or shape.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21, 1, 3, 7, 8, 13, 15, 17, 19, 22, 2, 12, 14, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanashi et al. (US 6,475,585).

Yamanashi et al. provides a flexible pad having an upper surface and a lower surface, with a non-slip texture on the lower surface (column 16, lines 45-55: figure 4, identifier 23). The upper surface of the flexible pad having a releasable adhesive coating and the lower surface having indicia provided thereon to decorate the pad (figure 4, identifier 25: column 16, lines 39-43) (column 17, lines 20-30). A peelable film to cover and preserve the adhesive material until used (figure 4, identifier 27: column 16, lines 43-44).

It would have been obvious to have provided the indicia on the lower surface of the pad to be any color, pattern, graphic design, text, advertising, relief design and texture as desired for end use and aesthetic appeal, since indicia is known to have

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many different colors, patterns, graphic designs, texts, advertising, relief designs or textures and can be selected by one having ordinary skill in the art for aesthetic purposes.

It would have been obvious to have provided the pad of Yamanashi et al. being removably secured to a body part, since the adhesive material could secure the pad of Yamanashi et al. to any surface as desired including a wearer's body part for aesthetic purposes.

It would have been further obvious to have provided the pad of Yamanashi in the same methods as described in claims 2, 8, 12, 14, 16, 18, 20 and 22, since applying the pad of Yamanashi et al. to any surface would decorate the surface of which it is applied to including a body part. It would have been further obvious to have trimmed the pad of Yamanashi et al. to any shape and size as desired, since the shape and size of a pad can be determined based upon the location to which the pad is to be applied to fit properly.

It would have been obvious to have applied the pad of Yamanashi et al. to any surface of the human or animal body including feet, hands, knees or elbows, since nothing prevents the pad from being applied to human/animal feet, hands, knees or elbows and doing so would only take one of ordinary skill in the art to decide the proper location. It is further obvious that the pad of Yamanashi et al. would conform to any site to which it is applied, since the pad of Yamanashi et al. is made out of a foamed substrate and is therefore flexible.

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It would have been further obvious to have applied to pad of Yamanashi et al. to any surface including the hand, elbow and feet of a user. The pad of Yamanashi et al. applied to the feet, elbow and hand of a user would protect the user's hand, elbow and feet therefore providing protection similar to shoes, elbow pad and glove apparel which purpose is to protect hands, elbows and feet from abrasion.

It would have been obvious to have provided the adhesive tape being reusable, since adhesive tape being reusable allows for the user to reposition or re-place the pad at different locations without having the adhesive become inactive and therefore the pad having to be disposed.

### ***Response to Arguments***

All claims are finally rejected under art and new grounds of rejection. All claims were amended in office action filed 11/21/02, Examiner's response incorrectly analyzed the amendment and therefore has caused the new grounds of rejection properly made final.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jones, Kuo et al., Charley, Darcey, Ruth, Lesko et al., Safdie, do Canto, Porcelli, Barre, Abrams, Harrison, O'Neill, Coomes, Price and Ludwig are all cited to show closely related pad articles.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (703) 308-6094. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0758 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

alh  
June 23, 2003



JOHN J. CALVERT  
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